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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 10/751,412 | 01/06/2004 | Takehiko Murata | 0229-0791P | 3177 |
| 2292 | 7590 | 06/06/2006 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH | | | MAKI, STEVEN D | |
| PO BOX 747 | | | ART UNIT | |
| FALLS CHURCH, VA 22040-0747 | | | PAPER NUMBER | |

1733

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/751,412 | Applicant(s) MURATA, TAKEHIKO | |
| | Examiner Steven D. Maki | Art Unit 1733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No: _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Incorporation of "while gradually increasing the width thereof [the width of the wide end portion of the auxiliary oblique groove] from the narrow middle portion" into the specification. The above noted subject matter is reasonably conveyed by (1) the illustration in figure 2 of the width of the axial inner end 6i gradually increasing from the narrower middle portion 6k to the main oblique groove 5 and (2) the description of "... and the axial inner end 6i thereof is connected with the main oblique groove 5, whereby the water drainage can be improved ...-- on page 10 of the original disclosure.

2) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3) Claims 1-6 and 8-15 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is the subject matter of the negative limitation of "without branching off". There is no explicit support

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for this negative limitation in the original disclosure and it is not seen how the original figures supports "without branching off". The original disclosure fails to define and/or provide guidance as to "branch" or "branching". For support, applicant directs attention to figure 2. Figure 2 illustrates the auxiliary oblique groove. However, it cannot be determined from figure 2 whether or not the auxiliary groove "branches off" in the depth direction. Furthermore, figure 2 fails to reasonably convey selectively targeting the specific range of groove configurations in which the auxiliary oblique groove extends "without branching off".

In claim 1, the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is the subject matter of the narrow middle portion having a groove width of more than 0.5 mm.

Applicant directs attention to page 11 for support. The original disclosure including page 11 supports the narrow middle portion having a groove width of more than 0.5 mm and not more than 3.0 mm, but not the open ended range of more than 0.5 mm. In claim 1 line 19, it is suggested to insert --and not more than 3.0 mm-- after "groove width of more than 0.5 mm".

In claims 14 and 15, the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is the subject matter of the negative limitation of the "axially inner regions being "provided with no further groove" and the subject matter of the axially outer

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regions being "provided with no further groove" respectively. There is no explicit support for these negative limitations in the original disclosure and it is not seen how the original figures supports "no further groove" in either the axially inner regions or the axially outer regions. Applicant directs attention to figure 2. Figure 2 shows "further grooves" instead of "no further groove". For example, figure 2 illustrates oblique shoulder grooves 7 and auxiliary shoulder grooves 8 in the axially outer regions. Figure 2 fails to reasonably convey that applicant had possession of selectively excluding "further grooves", but not excluding sipes, notches, holes, etc.

4) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5) Claims 1-6 and 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the scope and meaning of "without branching off" is ambiguous. It is unclear what constitutes a "branch", which would be excluded by "without branching off". It is noted again that the original disclosure provides no definition and /or guidance as to the meaning of "branch" or "branching". Does "branch" read on --groove--? Does "branch" read on --sipe--? Does "branch" read on --notch--?

With respect to "thereof" (claim 1 line 21), it is unclear what has the gradually increasing width. In claim 1 line 21, it is suggested to change "thereof" to --of the wide end portion--.

Allowable Subject Matter

6) **Claim 16 is allowed.**

Claims 1-6 and 8-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

The prior art rejections based on Himuro (US 6,892,775) in the last office action have been withdrawn in view of the amendments to claim 1.

Boiocchi et al (US 2002/0005238) discloses third transverse cuts 10 in shoulder blocks 7 which are separated by straight grooves. However, the prior art of record including Boiocchi et al, fails to disclose, teach or suggest an axially inner region having main oblique grooves each having the claimed angles $\theta 1$ and $\theta 2$ and the axially inner region having auxiliary oblique grooves each having a narrow middle portion having a groove width of more than 0.5 mm and not more than 3.0 mm and a wide end portion connecting to the one of the axially adjacent main oblique grooves while gradually increasing the width of the wide end portion from the narrow middle portion in combination with the remaining limitations of claim 1.

Remarks

7) Applicant's arguments with respect to claims 1-6 and 8-15 have been considered but are moot in view of the new ground(s) of rejection.

8) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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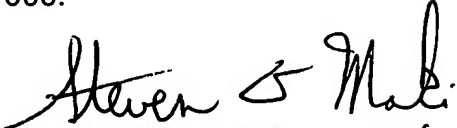
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steven D. Maki
May 26, 2006


STEVEN D. MAKI
PRIMARY EXAMINER
5-26-06